

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

MARCEL FASHIONS GROUP, INC.,

Plaintiff,

v.

LUCKY BRAND DUNGAREES, INC., LIZ
CLAIBORNE, INC., and LUCKY BRAND
DUNGAREES STORES, INC.,

Defendants.

11 Civ. 5523 (LTS)

ECF CASE

**DECLARATION OF
DARREN W. JOHNSON**

Darren W. Johnson declares under penalty of perjury, pursuant to 28 U.S.C. § 1746, as follows:

1. I am counsel with the law firm of Paul, Weiss, Rifkind, Wharton & Garrison LLP ("Paul, Weiss"), representing defendants Lucky Brand Dungarees, Inc., Liz Claiborne, Inc., and Lucky Brand Dungarees Stores, Inc. (collectively, "Lucky Brand"), and I am admitted to practice before this Court. I make this declaration in support of Lucky Brand's motion for summary judgment and Lucky Brand's opposition to plaintiff's motion for leave to amend the complaint. The statements herein are based on personal knowledge and a review of the files and records in this action and in prior litigation between the parties.

Marcel's Proposed Amended Complaint

2. The above-captioned action was reassigned to this Court on September 14, 2011. That same day, this Court issued an Initial Conference Order, directing the parties to draft a Joint Pre-Conference Statement. The parties' Joint Pre-Conference Statement, filed on October 5, 2011, indicated that Lucky Brand intended to move for summary judgment, and suggested the following briefing schedule:

- Lucky Brand's opening brief to be filed on or before December 9, 2011.

- Marcel's opposition to be filed on or before January 20, 2012.
- Lucky Brand's reply to be filed on or before February 10, 2012.

At the Initial Pre-Trial Conference held on October 12, 2011, the Court approved the parties' briefing schedule as set out in the Pre-Conference Statement. Nowhere in the Pre-Conference Statement, and at no time during the court conference, did Marcel ever suggest that it intended to amend its complaint.

3. Only ten days before Lucky Brand was scheduled to file its motion for summary judgment, on November 29, 2011, Reeves Carter, counsel for Marcel Fashions Group, Inc. ("Marcel"), notified me that Marcel intended to amend its complaint and promised to provide Lucky Brand with a copy of the proposed amended complaint no later than December 5, 2011. Marcel did not provide a copy of the proposed amended complaint on December 5, 2011, as promised.

4. Rather, on December 5, 2011, Marcel wrote a letter to the Court notifying it of its intent to seek leave to amend its complaint, and requesting an adjournment of the summary judgment briefing schedule. In its letter, Marcel also promised to send a copy of the proposed amended complaint to Lucky Brand by no later than December 9, the date that Lucky Brand was due to file its summary judgment motion according to the approved schedule. Marcel did not provide a copy of the proposed amended complaint on December 9, 2011, as promised.

5. Marcel finally sent Lucky Brand the promised copy of the proposed amended complaint on December 14, 2011, five days later than Marcel represented to the Court, and nine days later than it originally represented to Lucky Brand.

6. When Marcel first provided Lucky Brand with a copy of its proposed amended complaint on December 14, 2011, the first numbered paragraph of the proposed

amendment alleged that Lucky Brand “continu[ed] to use both the GET LUCKY trademark, as well as derivatives, variations and colorable imitations thereof.” (*See* Exh. 26 (Dec. 14, 2011 Draft [Proposed] First Am. Compl.) ¶ 1 (emphasis added).) After corresponding with Marcel’s counsel regarding the good-faith basis under Rule 11 for such an allegation, Marcel changed the wording of the first numbered paragraph to eliminate any reference to Lucky Brand’s continued use of the “Get Lucky” trademark. Marcel filed its motion for leave to amend the complaint, attaching this revised draft of the proposed amended complaint, on December 23, 2011.

Marcel’s “Get Lucky” Trademark

7. Despite our best efforts, we have not been able to find any reliable information concerning the nature and extent of Marcel’s business or its “Get Lucky” brand. The website for the “Get Lucky” brand (www.getluckyjeans.com) does not appear to have been updated in many years. And although the website purports to identify retail outlets that sell “Get Lucky” products, in fact none sells any such goods.

8. In particular, the website identifies eight retail stores that purportedly sell “Get Lucky” clothing: (1) Dr. Jays (NYC), (2) Trends (Atlanta), (3) Glik’s (Midwest), (4) V.I.M. (NYC), (5) World of Denim (Orlando), (6) Belk’s Department Stores (Southeast), (7) Bealls Department Stores (Florida), and (8) Peebles (Virginia).

9. I directed Michael Feldman, a law clerk with Paul, Weiss, to call each of these stores to determine if any, in fact, sold clothing under the “Get Lucky” mark. Mr. Feldman called Dr. Jays stores in Manhattan, Brooklyn, Queens and the Bronx. None sell “Get Lucky” clothing. Mr. Feldman was unable to find any stores named “Trends” in Atlanta, but he called both Trends Menswear and Citi Trends. Neither sells “Get Lucky” clothing. Mr. Feldman called Glik’s stores in Indiana, Minnesota and Wisconsin. None sell “Get Lucky” clothing. Mr.

Feldman called V.I.M. stores in Manhattan, Brooklyn, Queens, the Bronx and Far Rockaway. None sell “Get Lucky” clothing. Mr. Feldman looked for World of Denim in Orlando, but it appears to have gone out of business. Mr. Feldman called Belk’s Department Stores in Florida, Georgia and Alabama. None sell “Get Lucky” clothing. Mr. Feldman called Bealls Department Stores in Tallahassee, Jacksonville and Miami. None sell “Get Lucky” clothing. Mr. Feldman called the corporate offices of Peebles, which is owned by the same parent company as Bealls. They confirmed that none of their stores sell “Get Lucky” clothing.

10. Furthermore, there does not appear to be any reference to any “Get Lucky” products being available for sale anywhere else.

11. Indeed, on January 12, 2012, I conducted a search on Google.com for “Get Lucky.” I looked through the top 100 search results and found that not a single one of those results had anything to do with Marcel’s “Get Lucky” brand.

The Lucky Brand Trademarks






12. The Lucky Brand registered trademarks include, but are not limited to, the following marks:



Mark	Registration No.	Registration Date	Incontestable?
LUCKY	3,417,110	Apr. 29, 2008	
LUCKY and Yin Yang Design	3,517,270	Oct. 14, 2008	
LUCKY BRAND	3,407,935	Apr. 8, 2008	
LUCKY BRAND	2,756,608	Aug. 26, 2003	Yes
LUCKY BRAND	2,795,162	Dec. 16, 2003	
LUCKY BRAND	2,725,491	June 10, 2003	Yes
LUCKY BRAND	3,104,220	June 13, 2006	
LUCKY BRAND	3,981,713	June 21, 2011	
LUCKY BRAND	1,646,123	May 28, 1991	Yes
LUCKY BRAND	2,572,426	May 28, 2002	Yes
LUCKY BRAND	2,655,004	Nov. 26, 2002	Yes
LUCKY BRAND	3,699,407	Oct. 20, 2009	
LUCKY BRAND	3,506,278	Sept. 23, 2008	

Mark	Registration No.	Registration Date	Incontestable?
LUCKY BRAND BLUE JEANS	2,703,123	Apr. 1, 2003	Yes
LUCKY BRAND DUNGAREES	2,686,829	Feb. 11, 2003	Yes
LUCKY BRAND DUNGAREES and Clover Design	3,107,591	June 20, 2006	
LUCKY BRAND DUNGAREES OF AMERICA TOO TOUGH TO DIE and Design	2,158,107	May 19, 1998	Yes
LUCKY BRAND FOUNDATION and Design	2,271,432	Aug. 24, 1999	Yes
LUCKY BRAND JEANS	3,041,039	Jan. 10, 2006	Yes
LUCKY GIRLS	3,378,468	Feb. 5, 2008	
LUCKY HOUND	3,379,267	Feb. 5, 2008	
LUCKY KID	3,387,018	Feb. 19, 2008	
LUCKY KID	3,500,183	Sept. 9, 2008	
LUCKY LEGEND	3,775,279	Apr. 13, 2010	
LUCKY ME	2,469,997	July 17, 2001	
LUCKY NUMBER 6 and Design	3,265,128	July 17, 2007	
LUCKY SILVER	3,662,935	Aug. 4, 2009	
LUCKY YOU	1,739,962	Dec. 15, 1992	Yes
LUCKY YOU	2,306,342	Jan. 4, 2000	Yes
LUCKY YOU and Fly Label Design	1,886,118	Mar. 28, 1995	Yes
LUCKY YOU LUCKY BRAND	2,583,368	June 18, 2002	Yes
LUCKY YOU LUCKY BRAND and Design	2,724,936	June 10, 2003	Yes
Pocket Lining Design	2,129,881	Jan. 20, 1998	Yes
Zipper Clover Design	2,113,726	Nov. 18, 1997	Yes
Clover Design	2,400,358	Oct. 31, 2000	Yes
Inside Fly Label Design	2,050,091	Apr. 8, 1997	Yes

13. The proposed amended complaint, as filed with the court on December 23, 2011, alleges that Lucky Brand registered certain of these trademarks fraudulently because Lucky Brand was “well aware of Plaintiff’s superior and exclusive rights to and interests in

Plaintiff's GET LUCKY Mark . . ." at the time Lucky Brand filed its registrations. The proposed amended complaint enumerates the following marks as those alleged to be fraudulently registered:

Mark	Registration No.	Registration Date	Live/ Canceled	Canceled Date
LUCKY BRAND	1,646,123	May 28, 1991	Live	
LUCKY BRAND	2,330,052	Mar. 14, 2000	Canceled	Oct. 15, 2010
 LUCKY 	2,381,638	Aug. 29, 2000	Canceled	Apr. 1, 2011
WEAR US  BE LUCKY	2,383,437	Sept. 5, 2000	Canceled	Apr. 8, 2011
LUCKY YOU	2,306,342	Jan. 4, 2000	Live	
	3,107,591	June 20, 2006	Live	
	2,158,107	May 19, 1998	Live	
LUCKY ME	2,469,997	Jul. 17, 2001	Live	
LUCKY YOU	1,739,962	Dec. 15, 1992	Live	

Mark	Registration No.	Registration Date	Live/Canceled	Canceled Date
	2,400,358	Oct. 31, 2000	Live	
	2,129,881	Jan. 20, 1998	Live	
LUCKY BRAND DUNGAREES	2,686,829	Feb. 11, 2003	Live	

Not a single one of these Lucky Brand trademarks includes the words “Get Lucky.” And each and every one of these Lucky Brand trademarks was registered before this Court made a final ruling on the scope of the parties’ rights in its Final Order and Judgment in the 2005 Action, entered on June 1, 2010. Furthermore, three of these marks have already been canceled. Finally, 10 out of the 12 marks were registered while Marcel did not have an active trademark registration for GET LUCKY—between November 4, 1992, when the U.S. Patent and Trademark Office (“USPTO”) first canceled Marcel’s GET LUCKY trademark, and September 23, 2003, when the USPTO first re-registered Marcel’s mark.

The Exhibits Attached Hereto

14. Attached hereto are true and correct copies of the following exhibits:

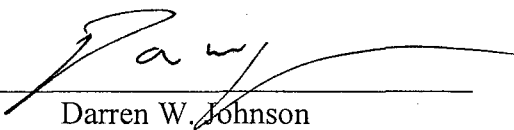
- Exhibit 1. U.S. trademark registration certificates for Marcel’s registered trademarks and the TARR status from the USPTO for each: Reg. No. (1,377,345) (1986), Reg. No. (2,765,974) (2003), Reg. No. (3,890,282) (2010), Serial. No. (78259867).
- Exhibit 2. U.S. trademark registration certificates for various of Lucky Brand’s registered trademarks and the TARR status from the USPTO for any of these marks which are incontestable: Reg. No. (3,417,110) (2008), Reg.

No. (3,517,270) (2008), Reg. No. (3,407,935) (2008), Reg. No. (2,756,608) (2003), Reg. No. (2,795,162) (2003), Reg. No. (2,725,491) (2003), Reg. No. (3,104,220) (2006), Reg. No. (3,981,713) (2011), Reg. No. (1,646,123) (1991), Reg. No. (2,572,426) (2002), Reg. No. (2,655,004) (2002), Reg. No. (3,699,407) (2009), Reg. No. (3,506,278) (2008), Reg. No. (3,703,123) (2003), Reg. No. (2,686,829) (2003), Reg. No. (3,107,591) (2006), Reg. No. (2,158,107) (1998), Reg. No. (2,271,432) (1999), Reg. No. (3,041,039) (2006), Reg. No. (3,378,468) (2008), Reg. No. (3,379,267) (2008), Reg. No. (3,387,018) (2008), Reg. No. (3,500,183) (2008), Reg. No. (3,775,279) (2010), Reg. No. (2,469,997) (2001), Reg. No. (3,265,128) (2007), Reg. No. (3,662,935) (2009), Reg. No. (1,739,962) (1992), Reg. No. (2,306,342) (2000), Reg. No. (1,886,118) (1995), Reg. No. (2,583,368) (2002), Reg. No. (2,724,936) (2003), Reg. No. (2,129,881) (1998), Reg. No. (2,113,726) (1997), Reg. No. (2,400,358) (2000), Reg. No. (2,050,091) (1997).

- Exhibit 3. Complaint in the action captioned *Marcel Fashion Group, Inc. v. Lucky Brand Dungarees, Inc., and Federated Department Stores, Inc.*, Case No. 01-7495-Civ-Dimitrouleas (S.D. Fla.) (the “2001 Action”), dated September 20, 2001.
- Exhibit 4. Order Denying Preliminary Injunction in the 2001 Action, dated February 13, 2002.
- Exhibit 5. Pre-Trial Stipulation in the 2001 Action, dated April 21, 2003.
- Exhibit 6. Release and Settlement Agreement in the 2001 Action, executed May 20, 2003.
- Exhibit 7. Complaint in the action captioned *Lucky Brand Dungarees, Inc., Liz Claiborne, Inc. v. Ally Apparel Resources, LLC d/b/a Get Lucky, Key Apparel Resources, Ltd., Marcel Fashion Group, Inc. and Ezra Mizrachi*, Civil Action No. 05-CV-6757 (LTS)(MHD) (S.D.N.Y.) (the “2005 Action”), dated July 27, 2005.
- Exhibit 8. Answer and Counterclaims in the 2005 Action, dated September 15, 2005.
- Exhibit 9. Order Granting Partial Summary Judgment and Injunction in the 2005 Action, dated April 22, 2009.
- Exhibit 10. Second Amended Joint Pre-Trial Statement in the 2005 Action, dated May 11, 2009.
- Exhibit 11. Excerpts from the 2005 Action Trial Transcript, dated April 22, 2010.
- Exhibit 12. Jury Verdict Form in the 2005 Action, dated April 22, 2010.
- Exhibit 13. A May 13, 2010 email exchange between Ryan Levy of Waddy & Patterson, P.C., counsel for Lucky Brand in the 2005 Action, and Ann Schofield Baker of McKool Smith, P.C., counsel for Marcel in the 2005 Action, and the attached draft of the Final Order and Judgment.

- Exhibit 14. A May 13, 2010 email from Katherine Thornburgh of McKool Smith, P.C., counsel for Marcel in the 2005 Action, to the Orders and Judgments Clerk of the Southern District of New York, and the attached draft of the Final Order and Judgment.
- Exhibit 15. Final Order and Judgment in the 2005 Action, signed on May 28, 2010, and entered on June 1, 2010.
- Exhibit 16. Complaint in the current action captioned *Marcel Fashions Group, Inc. v. Lucky Brand Dungarees, Inc., Liz Claiborne, Inc., and Lucky Brand Dungarees Stores, Inc.*, Civil Action No. 11-CV5523 (LTS) (S.D.N.Y.) (the “Current Action”), dated April 29, 2011.
- Exhibit 17. Marcel’s Motion for Permanent Injunction in the Current Action, dated May 4, 2011.
- Exhibit 18. Declaration of John F. Triggs, executed May 17, 2011, and filed on May 27, 2011.
- Exhibit 19. Lucky Brand’s Motion to Transfer Venue and Incorporated Memorandum of Law in Support in the Current Action, dated May 27, 2011.
- Exhibit 20. Marcel’s Response to Lucky Brand’s Motion to Transfer Venue in the Current Action, dated June 6, 2011.
- Exhibit 21. Answer in the Current Action, dated June 28, 2011.
- Exhibit 22. Magistrate Judge Robin Rosenbaum’s Report and Recommendation regarding Lucky Brand’s Motion to Transfer Venue in the Current Action, dated July 19, 2011.
- Exhibit 23. Order of Judge William Zloch Transferring the Current Action to the United States District Court for the Southern District of New York, dated August 8, 2011.
- Exhibit 24. Joint Pre-Conference Statement in the Current Action, dated October 5, 2011.
- Exhibit 25. Marcel’s Letter to the Court in the Current Action notifying the Court of Marcel’s intent to seek leave to amend the complaint and requesting an adjournment of the summary judgment briefing schedule, dated December 5, 2011.
- Exhibit 26. Draft [Proposed] First Amended Complaint sent to Darren Johnson of Paul, Weiss, counsel for Lucky Brand, on December 14, 2011.
- Exhibit 27. Marcel’s Memorandum of Law In Support of Plaintiff’s Motion for Leave to Amend Its Complaint, dated December 23, 2011.
- Exhibit 28. Marcel’s [Proposed] First Amended Complaint, as filed with the Court, dated December 23, 2011.

I declare under penalty of perjury that the foregoing is true and correct. Executed
on January 23, 2012 in New York, New York.



Darren W. Johnson